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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,661	08/03/2001	Pramod K. Arora	495263010035	8348

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,661

Applicant(s)

ARORA ET AL.

Examiner

Jeffrey B. Robertson

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-145 is/are pending in the application.
- 4a) Of the above claim(s) 36-136, 138, 139 and 141 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 143 and 144 is/are rejected.
- 7) ☒ Claim(s) 137, 140, 142 and 145 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/3/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 36-135 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: For claims 36-135 are directed to products containing amphiphilic molecules or polymers and solid state inert materials for use in vapor deposition. Claims 136-145 of the newly presented claims are directed to compositions containing amphiphilic molecules or polymers, alkylsilsesquioxane polymers and inert binders. These inventions are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the compositions of claims 136-145 have separate utility such as in emulsion or spray coating materials for dielectric materials.

For claims 136, 138, 139, and 141, these claims are related to original claims 1-14 (and present claims 137, 140, and 142-145) as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the compositions of claims 137, 140, and 142-145 have separate utility such as in emulsion or spray coating materials for dielectric materials. Claims 136, 138, 139, and 141 comprise amphiphilic molecules or polymers, which may contain alcohols, amides, amines, and sulfonates as amphiphilic groups and are not suitable for dielectric materials. Since applicant has already received an action on alkylsilsesquioxane polymers, specific to new claims 137,

Art Unit: 1712

140, and 142-145, alkylsilsesquioxane has been constructively elected by original presentation for prosecution on the merits.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 36-136, 138,139, and 141 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Applicant argues that the restriction requirement is not well taken and should only have been a three-way requirement. The examiner disagrees. First, it is noted that applicant elected without traverse. The essence of applicant's argument appears to be that original claims 1-14 and original claim 15 should not have been separated. In response, the examiner notes that the term "amphiphilic molecules" is fundamentally different than the recitation of alkylsilsesquioxane polymer. First, applicant makes a distinction between amphiphilic molecules and amphiphilic polymers. The number of materials and areas of search of compositions containing amphiphilic molecules versus compositions of alkylsilsesquioxane polymers or even claims limited to amphiphilic polymers is extremely burdensome to the examiner since it would involve non-silicon containing organic compounds as well as non-silicon containing polymers. These different compounds and polymers would require searches in numerous subclasses not required in a search for alkylsilsesquioxanes. In addition, applicant argues that all the products are for use in vapor deposition. It is noted that original claims 1-14 and new

Art Unit: 1712

claims 136-145 do not set forth such a limitation. For these reasons, the examiner disagrees with applicant's arguments.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 143 and 144 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 6, and 9 of copending Application No.

10/461,967. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Claims 143 and 144 of the instant application are identical to claims 6 and 9 (in view of claim 1) of application serial no. 10/461,967 (see attached copy of US 2003/0203110).

Claim Objections

5. Claim 145 is objected to because of the following informalities: For claim 145, alkylsilsesquioxane is spelled incorrectly. Appropriate correction is required.

Allowable Subject Matter

6. Claim 145 would be allowable if rewritten or amended to overcome the claim objection set forth in this Office action.


7. Claims 137, 140, and 142 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR